

*United States Court of Appeals
for the Second Circuit*



AMICUS BRIEF

75-7308

75-7308

B
PLS

In the

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

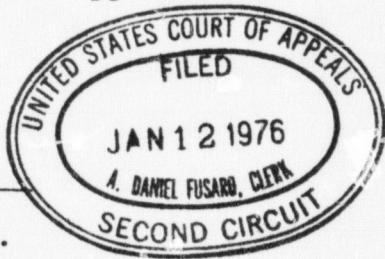
L. BATLIN & SON, INC.,

Plaintiff-Appellee,

vs.

JEFFREY SNYDER, d/b/a/ J.S.N.Y. and
ETNA PRODUCTS CO., INC.

Defendants-Appellants.



BRIEF OF E. MISHAN & SONS, INC.
AS AMICUS CURIAE

JAMES E. SIEGEL
MYRON GREENSPAN
LACKENBACH, LILLING & SIEGEL
Attorneys for E. Mishan & Sons, Inc.
41 East 42nd Street
New York, New York 10017
(212) 986-7630

TABLE OF CONTENTS

	<u>Page No.</u>
Table of Cases, Statutes and Publications	ii
I. Facts	1
II. Issue on Rehearing	8
III. The decision of this Court must be reversed to maintain uniformity of its decisions.	9
IV. The act of copying should not be rewarded by a valid U.S. Copyright even if this involves labor or skill.	24
--Snyder's Contributions	31
V. The many precedents cited by defendants-appellants do not generate originality or creativity with respect to their copyrighted bank.	
VI. Snyder's copyright should additionally be declared invalid because the copyright notice on its published copies was insufficient.	35
VII. Conclusions.	49

TABLE OF CASES, STATUTES AND PUBLICATIONS

CASES

	<u>Page No.</u>
Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99 (2 Cir. 1951).....	14,
Alva Studios, Inc. v. Winninger 177 F.Supp. 265 (S.D.N.Y. 1959).....	22, 25
Amsterdam v. Triangle Publications, Inc. 189 F.2d 104 (3 Cir. 1951).....	30
Chamberlin v. Uris Sales Corporation 150 F.2d 512 (2 Cir. 1945).....	10, 11, 12, 13, 19, 20
Consolidated Music Pub. Inc. v. Hansen Publications, Inc. 339 F.Supp. 1161 (S.D.N.Y. 1972).....	14
Contemporary Arts, Inc. v. F. W. Woolworth Co., 93 F.Supp. 739 (D. Mass. 1950).....	36
Etna Products Co., Inc. et al. v. E. Mishan & Sons, 75 Civ. 428.....	41, 42
Florabelle Flowers, Inc. v. Joseph Markovits, Inc., 296 F.Supp. 304 (S.D.N.Y. 1968).....	6, 14, 20, 30
Gardenia Flowers, Inc. v. Joseph Markowits, Inc., 280 F. Supp 776 (S.D.N.Y. 1968).....	15, 18, 19, 20, 32, 33
Gerlach-Barklow Co. v. Morris & Bendien, Inc. 23 F.2d 159 (2 Cir. 1927).....	9, 13, 14
Herbert Rosenthal Jewelry v. Grossbardt 436 F.2d 315 (2 Cir. 1970).....	40, 47
L. & L. White Metal Cast Corp. v. Cornell Metal Spec. Corp., 353 F. Supp. 1170 (E.D.N.Y. 1972).....	40, 41, 47
M. M. Business Forms Corporation v. Uarco Incorporated, 374 F.Supp. 419 (SD Ohio 1972)....	14

Millworth Converting Corporation v. Slifka 276 F.2d 443 (2 Cir. 1960).....	14
O. W. Donald v. Uarco Business Forms 478 F.2d 761 (8 Cir. 1973).....	14, 20, 21
O. W. Donald v. Zack Meyer's T.V. Sales and Service, 426 F.2d 1027 (5 Cir. 1970).....	14
Pantone, Inc. v. A. I. Friedman, Inc. 294 F.Supp. 454 (S.D.N.Y. 1968).....	14
Prestige Floral v. California Artificial Flower Co., 201 F.Supp. 287 (S.D.N.Y. 1962).....	36
Puddu v. Buonamici Statuary, Inc. 450 F.2d 401 (2 Cir. 1971).....	14, 40, 47, 48
Tennessee Fabr. Co. v. Moultrie Mfg. Co. 421 F.2d 279 (5 Cir. 1970).....	47
Wihtol v. Wells 231 F.2d 550 (7 Cir. 1956).....	15

<u>STATUTES</u>	<u>Page</u>
17 U.S.C., §19	39, 40, 41
<u>PUBLICATIONS</u>	
Nimmer on Copyright	
Section 6.1	15
Section 81, 82 at page 30	38
Section 19.2	33
Section 8.3	17
Section 10	17
Copyright Office Circular No. 3	38
McCarthy, <u>Trademarks and Unfair Competition, §§3.1, 3.5</u>	42
Vandenburgh, <u>Trademark Law and Procedure, §1.20</u>	41
Compendium of Copyright Office Practices (1973), §§4.2.3.II.d.2.b and 4.2.3.II.d.5	46
Ina Hayward Bellows (1940), Old Mechanical Banks--A Comprehensive Study of the Subject of Mechanical Banks, with illustrations.	1
John D. Meyer (1948), A Handbook of Old Mechanical Penny Banks.	1, 2

IN THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

L. BATLIN & SON, INC., -----x

Plaintiff-Appellee, :

vs.

JEFFREY SNYDER, d/b/a J.S.N.Y.
and ETNA PRODUCTS CO., INC. : Appeal No. 75-7308

Defendants-Appellants. :

-----x
BRIEF OF E. MISHAN & SONS, INC.
AS AMICUS CURIAE

I. FACTS

Uncle Sam banks of the type under consideration have been known at least as early as June 8, 1886, when Design Patent No. 16,728 issued on a TOY SAVINGS BANK (A-14)*. The basic design of such a bank has long since been dedicated to the public and untold numbers of reproductions, identical or similar to the original, have been made through the years. These banks, now in the public domain, are well documented in collectors' books on toy banks.

[For example, "A Handbook of Old Mechanical Penny Banks," by John D. Meyer (1948) at page 58; and "Old Mechanical Banks - A Comprehensive Study of the Subject of Mechanical Banks, with Illustrations", by Ina Hayward Bellows (1940) at page 117].

* Joint Appendix references will be identified by the letter "A" followed by the page number.

A description of an "Uncle Sam" bank of the type which formed the basis of plaintiff's plastic reproductions, taken from the above Meyer book at page 58, is reproduced here for the Court's convenience:

"No. 231. Uncle Sam--A typical American bank. Uncle Sam in his usual dress stove pipe hat, blue full dress coat and red and white striped trousers leaning on his ever-present umbrella, stands on a four by five inch base. On the base is a carpet bag which opens when lever is pressed and the coin placed in Uncle Sam's extended hand falls into it. At the same time his whiskers start moving. The base has an embossed American Eagle on it and the words, "Uncle Sam" on streamers above it. The word "Bank" on each side. The trap is on back of base. Patented June 8, 1886."

In the early part of 1974, Jeffrey Snyder saw an antique "Uncle Sam" bank which was approximately eleven inches high and made out of cast metal. Snyder liked the bank and wanted to reproduce it for Etna's product line.

In April 1974, Snyder flew to Hong Kong and brought the cast metal bank with him. Snyder took the bank to Sanyei, his buying agent, and asked Sanyei if it could be reproduced for Etna's product line. Sanyei checked with several mold makers and selected Unitoy. [A-37, ¶9].

The representative from Unitoy, with the cast metal statue in front of him [A-38, ¶12], made some sketches of the antique bank for the purpose of making a model or mold. It was decided at the Hong Kong meetings that the size or height should be reduced in order to fit into the required price range. It was

additionally decided that in order to make this product to sell at the right price and to be the right weight, it should be molded in plastic. These decisions were given as instructions to the mold maker as part of Snyder's goal for his bank.

To make the bank more salable and transportable, the base of the bank was shortened and narrowed. Also, since the bank was to be molded from plastic, it was decided to change the shape of the satchel or carpet-bag and to include the umbrella in a one-piece mold for the Uncle Sam figure, so as not to have a problem with a loose umbrella or a separate molding process.

The above facts are from Snyder's own affidavits and there is no genuine issue as to any of these facts.

What becomes clear from the above facts is that Snyder liked the antique bank and wanted it for Etna's product line. However, to substantially reduce the cost it was decided to mold the bank out of plastic. To still further reduce the price, the size of the bank was made smaller to save on material. The only other differences, if any, appear to have been dictated by the requirements of the plastic molding process. Attaching the umbrella to make a one-piece mold is one example of this.

A number of differences are set forth in Snyder's Affidavit (A-40, ¶20). However, it is very difficult, if not impossible, to reproduce an object without introducing slight differences in the mold, and therefore the finished molded product,

that are dictated by the molding process. The great skill involved was recognized in the Rodin "Hands of God" case by the granting of a valid copyright, to be discussed below. However, unless the intent, goal or requirement exists for identical or precise reproduction, such slight deviations are normally tolerable, particularly when a cheap copy is "knocked off", as it was here, for distribution in large quantities and for making large profits.

No intent, goal or requirement existed in this case for identical or precise reproduction. Nowhere has Snyder stated that this was his goal and so instructed the mold maker. Snyder's primary concern was to add a cheap "Uncle Sam" bank to Etna's product line. In fact, aside from Snyder "liking" the antique, the only goals of Snyder were dictated by economics--to make the bank shorter, make it out of plastic, and simplify the molding process.

It therefore appears that the differences outlined in paragraph 20 of Snyder's Affidavit (A-40) are little more than imperfections in the mold copied from the original bank. These imperfections manifest themselves as no more than trivial differences not distinguishable by an ordinary observer. It was not within the average mold maker's skill to produce an exact smaller size reproduction of the bank in the short time required. In any event, haste in bringing a product to the market place appeared to outweigh the requirement for precision.

Now Snyder, siezing upon any possible differences which may be interpreted as creative or original, highlight these very imperfections, trivial or minor differences for the proposition that these should be given weight in determining the validity of his copyright. The mechanical skills or lack of skills by Snyder's mold maker or any other mold maker should not be determinative of a valid U.S. copyright. The contributions outlined in Snyder's Affidavit (A-40, ¶20), if these can be considered as contributions, are de minimis and should be rejected for upholding a copyright which will place a cloud on and will only serve to restrict free competition.

There is no question but that Snyder did instruct the mold maker to decrease the size of the original bank in Snyder's possession and to mold it out of plastic. Additionally, the base was to be made shorter and narrower and the umbrella was to be attached. All of these instructions, as suggested above, were based entirely on economic or functional considerations. All the other minor deviations from Snyder's cast iron bank were merely trivial, unintended and undesired errors in the copying of the original antique bank and in the making of the mold for the smaller plastic bank.

The above is confirmed by the fact that an initial model, copied from the original cast iron bank, was made for Snyder's approval. This first model was rejected because the "proportions and dimensions were wrong" and because the "appearance

would be improved by a uniform size reduction changing all parts proportionately." It therefore appears that the first model was a very poor copy of the cast iron bank since its proportions and dimensions were grossly incorrect. A second model which appears to have somewhat corrected the earlier model in some of these respects was approved by Snyder. It is the bank based on the second mold that Snyder has copyrighted. It is this bank for which Snyder claims inputs of "creativity" or "originality", which inputs Snyder repeatedly points out is at least partially evidenced or supported by his flight to Hong Kong and the expenditure of money to pay the mold maker.

This Court will undoubtedly recognize the very common practice of businessmen to determine if their products can be manufactured in the Far East, Florabelle Flowers, Inc. v. Joseph Markovits, Inc., 296 F.Supp. 304 (S.D.N.Y. 1968) at page 306. This practice is not limited to any specific field, and includes fields as diverse as simple toys, such as the "Uncle Sam" bank under consideration, as well as sophisticated and complex electronic and aerospace systems. Here, the Court will also no doubt recognize that Snyder, in taking the "Uncle Sam" bank to the Far East, did so for the pure and simple purpose of determining if he could "knock off" a cheap reproduction thereof. The businessman's first impulse in these "knock off" cases, as was Snyder's first impulse in this case, was to mold the product out of plastic since this represents an extremely inexpensive method of

reproducing the product in large quantities. It is mechanical and within the skill of the average mold maker to make whatever small changes from the basic or original design to produce still further economies. Such changes or deviations are generally satisfactory since they are consistent with providing the highest possible profit margins. The requirement for precise or identical reproduction is not one generally made in most of these cases since the prices of these "knock offs" compared to the prices of the "originals" do not warrant the additional expenses which may be necessary to reproduce the originals with great fidelity.

Snyder had to "copy" and "reproduce" the public domain "Uncle Sam" bank in order to be able to represent to his customers, as indeed he does, that his plastic "Uncle Sam" bank is an "OLD TIME" bank. Not only does Snyder refer to his bank as being an "OLD TIME" bank, but also uses the language "Collectors' Item". Moreover, Snyder's instructions are virtually the same as the description of the operation of the "Uncle Sam" bank that is described in the above-quoted material from the Meyer book at page 58. There is no sense in anyone kidding themselves: Snyder wanted to copy the antique "Uncle Sam" bank, he wanted his bank to look like and operate just like the antique "Uncle Sam" bank so that he could call his bank a "Collectors' Item". He had one problem: Cost. He chose another material, and he reduced the height. And so defendants-appellants gave birth to their "Uncle Sam" bank. The period of gestation was at best brief. There were no labor pains.

II. ISSUE ON REHEARING

The real issue on this rehearing is whether the differences between Snyder's "Uncle Sam" bank and the public domain bank, from which it was copied, are trivial or are they sufficiently distinguishable variations which would readily be apparent to an ordinary observer, it being emphasized that the bank in issue was copied and that this fact has been admitted.

III.

THE DECISION OF THIS COURT MUST BE REVERSED TO
MAINTAIN UNIFORMITY OF ITS DECISIONS.

The Second Circuit Court of Appeals has in the past provided guidance to the other circuits with respect to the quantum of originality and creativity necessary to support a valid U.S. Copyright. This Court has been consistent in its position through the years and courts in other circuits have persistently followed this Court and cited its decisions, as will become evident from the discussion that follows.

In 1927, this Court decided the case of Gerlach-Barklow Co. v. Morris & Bendien, Inc., 23 F.2d 159 (2 Cir. 1927). This was an action to restrain infringement of a copyright of a picture. The defendant in that case filed an affidavit alleging that the plaintiff's president had admitted that the theme of this picture was taken from another picture. Addressing itself to this allegation in the affidavit, this Court stated, at page 161:

"Very likely it was, but works of art, to be copyrightable, do not, like patents, need to disclose the originality of invention. While a copy of something in the public domain will not, if it be merely a copy, support a copyright a distinguishable variation will, even though it present the same theme." (Emphasis added).

The court, therefore, recognized that a copy or reproduction of something in the public domain is not sufficient to support a valid U.S. Copyright. In fact, the clear implication of the court's language is that minor or trivial variations, which are not distinguishable to the ordinary observer, are similarly not sufficient. It is only when a copy departs sufficiently from the original or public domain item so that there is a "distinguishable variation" readily discernible by an ordinary observer that the variation or copy of the item supports a valid U.S. copyright.

The landmark case on the issue under consideration is Chamberlin v. Uris Sales Corporation, 150 F.2d 512 (2 Cir. 1945). This was an action by Chamberlin against Uris Sales Corporation for copyright infringement. This Court affirmed a dismissal of the complaint by the District Court for the Southern District of New York. Judge Frank, starting at page 512, stated that:

"The first question with which we must deal is that of the validity of the copyright. Our starting point must be the Constitution. For, as the constitutional power to enact the Copyright Act, 17 U.S.C.A. §1 et seq., derives from Article 1, §8, that Act would be void if it went beyond granting monopolies (or exclusive franchises) to authors whose works 'promote the progress of science and the useful arts.'

Obviously the Constitution does not authorize such a monopoly grant to one whose product lacks all creative originality. And we must, if possible, so construe the statute as to avoid holding it unconstitutional. Plaintiff therefore must lose unless he has shown that his work contains some substantial, not merely trivial, originality and that the defendant sold copies embodying the original aspects of his work.

There remains one item to be considered. Plaintiff, as part of his registered rules, included a drawing of the board. Plaintiff copied this drawing from the traditional back-gammon board. However, plaintiff's copy contains some inadvertent defects in shading, adding nothing to its worth in any conceivable way and so minute as to escape the attention of the ordinary observer. If one made an unintentional error in copying which he perceived to add distinctiveness to the product, he might perhaps obtain a valid copyright on his copy, although the question would then arise whether originality is precluded by lack of intention. That question we need not consider. For plaintiff's error yields nothing new of substance or distinction. Without originality, his drawing, if stood alone, could not be the subject of a valid copyright. We assume, arguendo, that that fact does not invalidate the entire copyright. But since the only copying here was of that portion of the subject matter which, standing alone, could not validly be copyrighted, we hold there is no infringement." (Emphasis added).

This Court in Chamberlin has interpreted Article 1, §8 of the Constitution to mean that one cannot "promote the progress of science and the useful arts" when his product lacks all creative originality. The Court felt compelled in that case to void the copyright since failure to do the same would authorize an illegal monopoly. As quoted above, the Court indicated that the plaintiff must lose unless he has shown that his work contains some substantial, not merely trivial, originality.

The fact pattern in Chamberlin is very similar to this case on appeal. In Chamberlin, plaintiff used a public domain game and set out to copy the same. In doing so, as to be expected, the plaintiff did not make a perfect copy, but his copy contained certain inadvertent defects in shading which, the Court observed, added nothing to its worth in any conceivable way and were so minute as to escape the attention of the "ordinary observer".

It is not, therefore, of importance whether changes from a public domain item were made intentionally or unintentionally. The court in Chamberlin recognized that if one made an unintentional error in copying and this error added distinctiveness to the product, he might, "perhaps" obtain a valid copyright on his copy. The Chamberlin court did not eliminate the issue of whether originality would be precluded by lack of intention should the product have departed sufficiently from the public domain item so as to add distinctiveness to it. The court did not consider that question since it found that plaintiff's error yielded nothing new of substance or distinction. Not having departed sufficiently from the original, the court held that the requisite amount of originality was not present and that, therefore, the copyrighted item could not be the subject of a valid copyright.

Based upon the Gerlach and Chamberlin cases, it becomes immediately evident that a distinction must be made between originality and creativity with respect to most copyrightable works and those criteria with respect to works which are copied, based upon, derived from or are inspired by public domain works. Thus, while little or no difference need exist for a second author to obtain a copyright for his independently created work, the differences are closely scrutinized when the second author copies his works from a public domain item. The reason for this is obvious. The purpose of rewarding authors whose works "promote the progress of science and the useful arts" is because they add to the store of knowledge and for this reason are given limited monopolies to prevent others from copying their original works. On the other hand, one who merely copies a public domain item, an item which is readily available for use by all, and obtains a copyright on his copy effectively eliminates or removes that work from the public domain and reduces the availability of that work from the store of knowledge. For this reason, courts have consistently followed the two above decisions of this Court and have invalidated copyrights where the second author copied a public domain work without departing sufficiently therefrom so as to add substance or distinction to his new work. In order to add such substance or distinction to his work, the added material cannot be so minute as to escape the attention of the ordinary observer and must add something of worth to the new work so as to satisfy the constitutional requirement.

The most frequently cited case in this area is Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99 (2 Cir. 1951). This was an action by Alfred Bell against Catalda Fine Arts and others for infringement of eight separate copyrights covering mezzotints engravings of paintings of old master. Speaking through Judge Frank, the Court, starting at page 102, stated:

"It is clear, then, that nothing in the Constitution commands that copyrighted matter be strikingly unique or novel. Accordingly, we were not ignoring the Constitution when we stated that a 'copy of something in the public domain' will support a copyright if it is a 'distinguishable variation' (Citing Gerlach-Barklow Co. v. Morris & Bendien, Inc., supra)... all that is needed to satisfy both the Constitution and the statue is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own'. (Citing Chamberlin v. Uris Sales Corp., supra). Originality in this context 'means little more than a prohibition of actual copying'."

The three above decisions have consistently been quoted with approval and followed in this as well as in other circuits, Millworth Converting Corporation, v. Slifka, 276 F.2d 443 (2 Cir. 1960); Puddu v. Buonamici Statuary, Inc., 450 F.2d 401 (2 Cir. 1971); Pantone, Inc. v. A.I. Friedman, Inc., 294 F.Supp. 545 (SDNY 1968); Consolidated Music Pub, Inc. v. Hansen Publications, Inc., 339 F.Supp. 1161 (SDNY 1972); Florabelle Flowers, Inc. v. Joseph Markovits, Inc., 296 F.Supp. 204 (SDNY 1968); O. W. Donald v. Zack Meyer's T.V. Sales and Service, 426 F.2d 1027 (5 Cir. 1970); M. M. Business Forms Corporation v. Uarco, Incorporated, 347 F.Supp. 419 (SD Ohio 1972); O. W. Donald, v. Uarco Business Forms, 478 F.2d 761 (8 Cir. 1973); Gardenia Flowers,

Inc. v. Joseph Markovits, Inc., 280 F.Supp. 776 (SDNY 1968);

Wihtol v. Wells, 231 F.2d 550 (7 Cir. 1956).

The leading treatise on Copyright, "Nimmer on Copyright" (hereinafter referred to as Nimmer), discusses the essence of authorship at Section 6.1. It is particularly noted that those who have "slavishly or mechanically copied from others may not claim to be an author". Additionally, Nimmer states in this section that "Originality itself must exhibit a modicum of intellectual labor in order to constitute the product of an author (cases omitted)". Based on this, it is clear that Snyder cannot be an author. The smaller plastic bank is, to the extent of the skill of the mold maker and the above discussed economies slavishly or mechanically copied from a public domain antique bank. Snyder has not, it is submitted, advanced any evidence of "intellectual labor" other than that of a businessman instructing a mechanic to make a cheap reproduction or copy of an earlier work. "Originality", Nimmer states, "may be said to be the essence of authorship". Snyder admitted taking the cast metal bank to Hong Kong with him. He has admitted that the mold maker had the cast iron bank in front of him and was looking at it (A-38, ¶12) in making or preparing the mold. Can there be a clearer case of slavish or mechanical copying of a public domain work? Defendant thinks not. Based on this, Snyder cannot be an author, in the constitutional sense, and any copyright which he may have so authored must fail for lack of originality.

Despite the somewhat low level of originality which has generally been required in copyright, there is a lower limit below which courts view independent efforts as being too trivial or insignificant to support copyright.

This is particularly the case here because there is no effective control over what is copyrighted. Obtaining a certificate of registration from the Copyright Office is merely an administrative act. There is no examination, as in the case of patents, to determine the merits of the copyright. A federal certificate of registration automatically issues if the application therefor is in proper form and with it comes the presumption of originality and validity. It should be clear that this procedure is extremely dangerous when exercised by those who are not "authors", for an invalid copyright can nevertheless create much damage in the business world and may pivotally effect untold businesses. Of primary concern is the power of a not yet invalidated copyright to result in an injunction which eliminates free competition in the market place. This is exactly the case here, for even though the lower court granted the plaintiff-appellee's motion for preliminary injunction, the plaintiff-appellee and the Amicus still have not been able to freely compete with the others offering for sale and selling the "Uncle Sam" bank, including the defendants-appellants.

In the above connection, Nimmer states as follows at page 19., §8.3:

"Despite the liberal construction which has been applied in delineating the constitutional concept of writings, the courts have nevertheless prescribed certain minimum standards which a work must meet in order to attain this status. ...

In the Trademark Cases, one of the earliest Supreme Court decisions construing the Copyright Clause, it was stated that writings must constitute 'the fruits of intellectual labor.' ... The fundamental precept that a work is not a writing unless it contains a modicum of intellectual labor has been followed in subsequent cases, and clearly constitutes an essential constitutional element. ... simple directions dictated by functional considerations, even if original, do not contain sufficient intellectual labor to constitute writing (citations omitted)". (Emphasis added).

Without "creativity", plaintiffs are not entitled to a copyright on a work in Class 5(g) under the Copyright Act. Without "originality" plaintiffs are not entitled to copyright in any Class, and more specifically not in Class 5(g) nor in Class 5(h).

The subject of originality is generally discussed in Nimmer, at Section 10. Considering the quantum of originality necessary to support a valid copyright, Nimmer states at page 34.2:

"Any 'distinguishable variation' of a prior work will constitute sufficient originality to support copyright if such variation is the product of the author's independent efforts, and is more than merely trivial (citations omitted)" (Emphasis added).

A frequently cited recent case in this area is Gardenia Flowers, Inc. v. Joseph Markovits, Inc. (SD NY 1968), 280 F Supp 776 (hereinafter referred to as the Gardenia case). In this case, in an action for copyright infringement and unfair competition, Judge Levet, held that the copyrights were invalid for lack of creativity and originality.

The passages from Gardenia most applicable to this case are as follows, at pages 781 and 782:

That degree of creativity necessary to define objects as works of art is not supplied through innovations which are solely utilitarian or mechanical. Thus, the fact that plaintiff may have been responsible for adding certain practical features to the component parts of the flower arrangements, which facilitated their assembly and eliminated the need for certain manufacturing operations, does not overcome the absence of creativity inherent in the arrangements. Likewise, plaintiff's decision to use plastic material for fabrication of the articles may have added certain utilitarian advantages, such as durability or color retention over natural or cloth materials, but this, too, does not constitute the creativity required for copyright purposes. (Emphasis added)

The lack of creativity in the corsages herein involved is fatal to plaintiff's claims regarding the validity of its copyrights and infringements thereof.

Lack of creativity, however, is not the only fault to be found with plaintiff's corsages. They also are lacking in originality, and it is elementary that no work is entitled to copyright protection unless it is "* * * original, in that the author has created it by his own skill, labor, and judgement."

"The 'originality' requirement for copyrightability is not onerous." Indeed, it has been held that: " * * * practically anything novel can be copyrighted. * * * 'No matter how poor artistically the "author's" addition, it is enough if it be his own'. * * * " Moreover, it has been said that "[o]riginality in this context 'means little more than a prohibition of actual copying.'" (Emphasis added).

As with the question of creativity, though, the fact that only minimal standards need be applied does not prevent the court from concluding as a matter of fact that works may lack even the modicum of originality required. When the copyright claimant has added nothing of his own to a work, then copyright protection must be denied. (Emphasis added).

Much of the same reasoning which led this court to the determination that plaintiff's corsages were devoid of creativity applies with equal force to its claim of originality. Applying the standard that " * * * sameness or similarity is determined by the eye of the ordinary observer," it cannot be said that plaintiff's works represent anything new. (Citations omitted throughout above quotation)

Continuing at page 783, the Court in the Gardenia case stated:

"Finally, it must be noted that originality is not proved merely because plaintiff may have had the idea to produce artificial corsages made out of a new plastic material. There can be no copyright on an idea . . . The purpose of the copyright law is to protect creation, not mechanical skill (citations omitted)". (Emphasis added).

Courts in this Circuit have followed the case of Chamberlin v. Uris Sales Corporation, supra, in cases where an item in the public domain is copied and an attempt is made to copyright the copy where little or no originality is manifested by the new "author". In the Chamberlin case the copyright owner sought

to protect a game which was a variation of the backgammon game. In copying the board, some defects in shading resulted. The Chamberlin case exemplifies the proposition that "bad" copying resulting in trivial differences from the original does not elevate the work to one worthy of copyright protection. Such trivial errors are not to be rewarded by placing a cloud on use of something which was previously in the public domain and readily available for copying by all.

In Florabelle Flowers, Inc. v. Joseph Markovits, Inc. (SDNY 1968), 296 F.Supp. 304, a case similar in some respects to the instant case, the Court, citing the Gardenia case, stated at page 307, referring to the copyrighted flower:

"Whoever created it, the flower in issue seems to lack even the 'faint trace' of originality required for a copyright. Defendants make an impressive showing, thus far unanswered, that the kind of plastic flower in question, with 'face,' with or without a pot, and with the few other accoutrements this one displays, are all old and familiar elements of the trade in which both parties are engaged. I am not certain of this, but there is a strong likelihood that plaintiff cannot show more than the aggregation of well known components to comprise an unoriginal whole--the result falling short of the easy standard of originality required for a copyright. (citations omitted)" (Emphasis added.)

A very recent case in the Eighth Circuit of Appeals, Donald v. Uarco Business Forms (3th Cir. 1973) 478 F.2d 764, examined the validity of a copyright in an infringement action. The Court of Appeals held that where plaintiff had knowledge of, and drew upon, public domain material, that plaintiff in that case

failed to show the minimum degree of creativity and originality necessary to support a valid copyright. This case is deemed especially of interest because the copyrighted item was based on a very similar public domain item. Additionally, the Court recognized, at footnote 1 on page 765, the inherent problem with the procedure for obtaining copyright--namely a procedure without examination on the merits, only as to form. The portion of the opinion deemed most pertinent to this case appears on page 766 as follows:

"Where a work is based on a work already in the public domain, a valid copyright may not exist in the new work unless it shows more than a trivial variation from the old work. However, if a work is independently created, it is entitled to a copyright even though it is identical to a work in the public domain.

We have carefully reviewed the transcript of the trial and the records of the lower court, and find that the appellant had knowledge of, and drew upon, legal forms which already existed in the public domain when he drafted his form. Most of the form is phrased in standard legal language. The appellant's testimony leads us to the conclusion that he had seen similar language many times before.

The basic issue is whether the appellant's form shows the minimum degree of creativity and originality necessary to support a valid copyright. We do not believe that this difference makes the appellant's work more than a trivial variation from that already in the public domain. Therefore, the appellant is not entitled to a copyright on his 'Agreement.'" (Emphasis added).

The defendants-appellants place great reliance on the case involving the Rodin sculpture "Hand of God". However, based on the above discussion, and based on defendants-appellants' affidavits, the defendants-appellants themselves have clearly distinguished that case from the instant case. By pointing out all the trivial differences or deviations from the original public domain cast iron bank in Snyder's possession, defendants-appellants have admitted that they have not reproduced an exact faithful reproduction. In the "Hands of God" case (Alva Studios, Inc. v. Winninger [SDNY 1959], 177 F.Supp. 265), the plaintiff in that case sustained or carried the burden of proof to uphold its copyright, the Court stating at page 267:

"Plaintiff has sustained this burden. Its copyrighted work embodies and resulted from its skill and originality in producing an accurate scale reproduction of the original. In a work of sculpture, this reduction requires far more than an abridgement of a written classic; great skill and originality is called for when one seeks to produce a scale reduction of a great work with exactitude." (Emphasis added).

The defendants-appellants in this case have not carried their burden. They fall nowhere, neither in the category of exactitude required by the "Hand of God" case, nor in the category of independent creation. Their position is inconsistent and they therefore fall in no man's land, having produced what, at best, can be characterized as a "bad copy".

The net effect of this Court's majority decision of October 24, 1975, is to eliminate the fundamental or constitutional requirement repeated over and over by the above decisions. The majority decision cannot be interpreted in any other way but that it dispenses with the requirement that a copied work must depart from its public domain predecessor by more than merely trivial differences. In addition to possibly running counter to the constitutional mandate, the majority decision would create an unbearable burden upon merchants who cannot spend the time and the effort to microscopically examine each item that they purchase, sell or manufacture with the degree which would ~~not~~ be required in order to avoid infringement. The cases in this circuit have, up to now, recognized the practical limitations which are imposed upon merchants. For this purpose, a merchant cannot be expected to see any more than the ordinary observer and he should be permitted to rely upon what he ~~sees~~ without making a detailed analysis or study in each instance when he embarks upon the manufacture or sale of a new item. The principles enunciated in the cases of this circuit, therefore, overcome this practical problem by requiring that the changes or differences from the public domain works be readily distinguishable to an ordinary observer. Elimination of this requirement by this Court would substantially and adversely affect free competition and interstate commerce.

IV.

THE ACT OF COPYING SHOULD NOT BE REWARDED BY
A VALID U.S. COPYRIGHT EVEN IF THIS INVOLVES
LABOR OR SKILL.

Copying is substantially a mechanical act. This is particularly true in the case of a commercial mold-maker who routinely reproduces variously shaped objects. Creativity and originality is the antithesis of copying. A person cannot be original or creative if he has an earlier work in front of him and copies the same in arriving at his own work unless he departs sufficiently from the earlier work to produce more than "mere trivial" variations from the earlier work. It matters not how difficult or how much labor is involved. Copying, no matter what the mechanical or artistic process, is still copying and, therefore not original or creative. If this were not true, the requirements of creativity and originality would be eviscerated and replaced by the requirement of work or labor. This is clearly not the intent of Congress. Yet, this Court's majority decision in this case would have that result if taken to its logical conclusion.

As this Court has repeatedly announced in the past, a copy must manifest more than merely trivial differences as viewed through the eyes of an ordinary observer. Bad copies which evince minor variations are not protectable no matter how much work or labor is involved in producing the copy. The amount of money spent in arriving at the copy should similarly not control.

The only exception to this general rule was announced in the Alva Studios, Inc. v. Winninger case, supra, where an exact miniature of Rodin's "Hand of God" was accorded copyright protection because it required great skill and originality to produce an exact replica without introducing any differences whatsoever except for the size. Therefore, in this circuit, a copy must either be an exact reproduction or must depart substantially from the original so as to evince obvious contributions by the second author. Works which fall in between are deemed to be merely bad copies and are not accorded copyright protection. Accordingly, the majority decision in this case may be correct from a purely academic point of view. However, contributors of trivial variations are not really authors in the constitutional sense and this circuit has consistently refused to sustain their copyrights. Any other result would create a proliferation of worthless copyrights which would undoubtedly place a cloud on free competition since ordinary observers would not be able to distinguish between the copyrighted and the public domain works.

The majority decision, at page 3670, stated that the mold was sculpted independently "from scratch". This, of course, is not a true fact. As Snyder plainly states in his affidavits (A - 38) his molder proceeded to make the mold "while he was looking at" the public domain cast metal statue which Snyder had

brought to Hong Kong with him. There was never any question that the molder had the public domain bank in front of him at all times when he made the mold to copy the bank.

The majority court also believed that the witnesses for both parties conceded that the sculptor needed special skill, training and knowledge, and independent judgement to create the mold. However, a close examination of the Transcript of the Proceedings of May 6, 1975 (starting at A-48) indicates that there is some disagreement as to the degree of special skill or independent judgement required to create the mold. The expert witness, Bloch, for the Plaintiff-appellee indicated that certain changes had been made because it was easier to manufacture certain pieces with the changes (A-56, line 18). Additionally, this expert witness characterized the differences between the public domain bank and Snyder's bank as being merely trivial (A-57, line 15). This expert concluded that in his opinion the Snyder bank was merely a copy of the public domain bank (A-58, lines 6 and 15). Judge Metzner, with the public domain and Snyder banks in front of him, stated, from looking at the two, that one is an exact replica of the other except for size. (A-68, lines 11-14). The Court again observed that the two banks looked the same at A-84, lines 19 and 20.

The expert testifying on behalf of defendants-appellants was Mr. Daniel Wurmbrand. Asked how he would go about making a smaller version of the public domain bank, Mr. Wurmbrand stated that he would make a mold either by pantographing or by casting it (A-91, line 15). Asked by the Court at line 16 of that same page what is pantographing, the witness testified that it is duplicating. Duplicating, it is submitted, is just another word for copying. Starting at line 20 on that same page the witness described more specifically what the pantographing process is and described it as follows.

"By taking a model and putting it in one place, and on the other side we have a motorized spindle with a metal cutter, and we put another metal, whatever we want to make it from, and by tracing the model we can reduce it in size to the smaller part."
(Emphasis added). (A-91, starting at line 20).

Pantographing is the process used to trace or mechanically copy the smaller "Uncle Sam" bank. This is confirmed by the question by the attorney representing the defendants-appellants when he asked the witness Wurmbrand at A-92 whether the pantographing process was the only way to make an exact smaller copy and the witness responded that it would not be exact although he did not deny that it was the only way to make a smaller copy. In other words, a smaller copy made by the mechanical step of pantographing would be a crude model but smaller and substantially having the reduced or scaled proportions of the larger model. Thus, Mr. Wurmbrand states

at page A-92 of the record, starting at line 15 that "whatever comes out in the pantographing is very blurred out because it is a machining cutter that does the work. And after that you have to go in by hand and engrave it and sculpt out the details." The defendants-appellants have never denied that their molder copied the details from the larger public domain bank after they produced the pantographed or rough machined model. Based on the substantial similarity in appearance between the public domain and the Snyder banks, it must be concluded that the molder attempted to copy the details of the "Uncle Sam" bank. This would have conformed with the intentions or goals of Snyder in adding an old time or antique "Uncle Sam" bank to the Etna Product line.

When the expert Wurmbrand compared the metal and the plastic bank, he observed, on page A-93 of the record, starting at line 22 that the molder of the plastic bank changed some of the designs "in order to fit plastic". Additionally, the expert observed that the molder "changed some of the detail work." Any changes made to fit plastic are to be expected. Any experienced mold maker would have suggested and made the very same changes. The purpose of these changes is to reduce the manufacturing cost and therefore the cost of the product. Any changes in the detail work, while the mold maker sought to copy the details of the public domain "Uncle Sam" bank, occurred because the Snyder bank was made in a different medium, and because

some very slight or minor details were inevitable. However, because these details are so minor and trivial, they would not be readily ascertainable by an ordinary observer and therefore fail to rise to that level of originality required in this circuit. In fact, the expert Wurmbrand, at page A-94, starting at line 4, states that the details must be carved out after the pantographing process "even if it is a copy". In effect, Wurmbrand was saying that certain mechanical steps are always required even if the goal is simply to copy a prior item. The expert, on lines 19 and 20 of that same page admitted that he would call the Snyder an original artistic work simply because it is not the same exact bank in every last detail. However, Wurmbrand conceded that "I wouldn't call it a new design" since there was no originality or creativity in its formation. (A-94, lines 19-20).

Based upon the above analysis of the expert witnesses, it is submitted that they both conceded that certain skills are required. But this is true even if the only intent is to reproduce or copy a public domain device. What the experts have agreed upon, it seems, is that certain changes were made but that these were changes that were primarily mechanical and resulted from changes in size and medium. At all times during the formation of the Snyder bank, there was the goal of copying the larger "Uncle Sam" public domain bank and this bank was always in front of the molder when he made his mold. This Court should, therefore, reconsider whether there was slavish or mechanical

copying in this case. Based upon the testimony of the experts, it is submitted that there was.

Taking the majority decision of October 24, 1975 to its logical conclusion, copyrights should almost never be invalidated. In all cases, the second author performs some labor, uses some discretion or judgement and requires some skill, whether this be his own or that of another. Yet, this has not been the test in the past. Numerous copyrights have been invalidated despite the fact that the copyright owner did the very same or similar things as the defendant-appellant, Snyder, did in this case. In the Florabelle Flowers, Inc. v. Joseph Markovits, Inc. case, supra, the copyright owner had a general idea, discussed it with the people in Hong Kong, and no doubt made the very same decisions as Snyder did in this case. The Court nevertheless held, at page 307, that:

"Whoever created it, the flower in issue seems to lack even the 'faint trace' of originality required for a copyright (citing the Catalda case)".

In Amsterdam v. Triangle Publications, Inc., 189 F.2d 104 (3 Cir. 1951), the court found the evidence amply sufficient to show the various steps which the plaintiff took in making his map. These steps are listed on page 105 of that case and included:

1. . . . Studied every map of Delaware County that he could find.
2. . . . Gathered all the information from these maps which were in the possession of the plaintiff or in the posession of the township and municipal authorities.

3. . . . Obtained the state highway route numbers from the State Highway Department.
4. . . . Obtained the names of a few very small secondary roads from real estate developers.
5. . . . Spent considerable time and effort to assemble and prepare this information for publication."

The Court pointed out, however, that despite all this work or labor, the plaintiff did very little, if any, original work.

SNYLER'S CONTRIBUTIONS

What did Snyder contribute during the process of copying the antique cast iron bank? The differences which defendants-appellants allege include size, medium and a number of other minor differences. Which of these differences constituted Snyder's originality?

With respect to the reduction in size, as discussed above, defendants-appellants' own expert testified that the reduction was accomplished by "tracing" the original bank with a mechanical pantograph. Copying by any other means is still copying. Tracing, whether in two or three dimensions, is copying by any standard. Therefore, insofar as the difference in size, it is respectfully submitted that Snyder contributed nothing. Using the pantograph, the original could be scaled down to 10 inches, 8 inches or any other size. Should each different size arrived at by this mechanical means be the subject of a separate valid U.S. Copyright? Issuance of copyrights without a showing of originality would be a clear contravention of the U.S. Constitution and the Copyright

Act. The Court in Gardenia Flowers, Inc. v. Joseph Markovits, Inc., supra, at page 783 said:

" 'The purpose of the copyright law is to protect creation, not mechanical skill.' Shapiro, Bernstein & Co., Inc. v. Miracle Record Co., Inc., 91 F.Supp. 473, 475 (N.D.Ill. 1950)".

Here, Snyder, through his mold maker, only contributed mechanical skill in reducing the size of the original bank.

Next, Snyder had the idea of making the antique cast iron bank into plastic. But the idea of making something out of plastic has already been held not to be copyrightable in Gardenia Flowers, Inc. v. Joseph Markovits, Inc., supra, at 783, where the Court said:

"Finally, it must be noted that originality is not proved merely because plaintiff may have had the idea to produce artificial corsages made out of a new plastic material. There can be no copyright on an idea. Baker v. Selden, 101 U.S. 99, 25 L.Ed. 841 (1879); Uneeda Doll Co. v. P. & M. Doll Co., 353 F.2d 788 (2nd Cir. 1965)."

Additionally, the change or difference in medium is made less noticeable, in the first instance, because Snyder painted the plastic bank with the same color scheme as was the original cast iron bank. It is submitted, therefore, that an ordinary observer, looking at the two banks, could not readily distinguish the medium because they are both painted almost identically. For these two reasons, Snyder's copyright should not be sustained based on his use of plastic for his bank.

The only alleged differences that remain are those that arose out of bad copying or those that were inevitable due to the use of plastic. Therefore, as discussed above, the test of originality here is whether an ordinary observer could readily distinguish the differences. The differences, therefore, must not be trivial. In this connection, the Court in Gardenia Flowers, Inc. v. Joseph Markovits, Inc., supra, said at page 782:

" * * * * sameness or similarity is determined by the eye of the ordinary observer."

The experts, Bloch and Wurmbrand and Judge Metzner can certainly be considered to be at least "ordinary observers". Yet, as pointed out above, they all indicated that the banks were copied or that the differences were trivial or that the banks looked alike. The ordinary observer, under these circumstances, can certainly be expected to fail to distinguish and appreciate the differences alleged by defendants-appellants, which differences were no doubt arrived at by a painstaking and very exhaustive analysis. Giving weight to these trivial differences will only encourage Snyder and others to seek and enforce unlawful monopolies, as did the plaintiff in the Gardenia case, where the Court observed at page 782:

"Plaintiff's argument that requisite originality is demonstrated by slight irregularities of details in the component parts of the flower arrangements, which may be noticed only upon extremely close observation, is also of no avail." (Emphasis added).

When the copyright claimant has added nothing of his own to a work, then copyright protection must be denied. Nimmer, §19.2.

The fact that copyrights have been invalidated in this circuit indicates that it is not labor, work, money or even judgement which decides whether a copyright will be sustained, but only whether the author contributed sufficient originality and creativity to entitle him to such copyright under the constitutional standard. The majority decision of October 24, 1975 in this case is a radical departure from that long line of cases announcing that basic principle. Based upon the constitutional as well as the practical problems which such a decision would create, this Court is respectfully urged to reverse its decision so as to be consistent with the earlier cases of this circuit.

V. THE MANY PRECEDENTS CITED BY DEFENDANTS-APPELLANTS DO NOT GENERATE ORIGINALITY OR CREATIVITY WITH RESPECT TO THEIR COPYRIGHTED BANK.

As the defendants-appellants have done in earlier briefs, they have here again cited a plethora of cases, many of which do not stand for the propositions which the Court would be led to believe. In any event, the facts in this case are clearly distinguishable from the facts in those cases where copyrights have been upheld.

Most of the cases cited by the defendants-appellants in their Brief on Rehearing have already been cited and brought to the Court's attention, have already been analyzed, discussed and quoted in earlier briefs. Therefore, to respond to each of the cases cited by the defendants-appellants would just be an exercise in redundancy and a great burden on Amicus and this Court. At best, it can be said that numerous cases can be found where copyrights have been upheld. However, it is respectfully submitted that the defendants-appellants in this case have failed to carry the burden of proof to show this Court their "Uncle Sam" bank falls into that category or class of cases where a valid copyright exists. Amicus can respond and distinguish each of the cases cited by the defendants-appellants on the issues of originality and creativity, if the Court thinks that this is necessary. However, the relevant cases have already been cited and discussed. The facts in this case, taken from Snyder's own affidavits, are not in dispute. In any event, the banks speak for themselves.

Amicus does feel obliged to briefly distinguish some of the cases cited by the defendants-appellants because of the importance which they appear to attach to these. For example, defendants-appellants cite Prestige Floral v. California Artificial Flower Co., 201 F.Supp. 287 (SDNY 1962); and Contemporary Arts, Inc. v. F. W. Woolworth Co., 93 F.Supp. 739 (D. Mass. 1950); aff'd., 193 F.2d 162 (1 Cir. 1951); aff'd., 344 U.S. 228, 73 S.Ct. 222 (1952). Both of these cases have already been cited in defendants-appellants' prior briefs. In each case, a work of art was created based on a living entity. However, nowhere, to Amicus' best knowledge, do the facts in these cases show that the "authors" had a model in front of them from which a copy was made. On the contrary, in the Contemporary Arts case, supra, the Court stated at pages 741 and 742 that substantial research, original design and careful workmanship was the hallmark of plaintiff's statues, which statues sought to create with great exactitude and precision an item which was not a copy of a product of another person's creativity. Nowhere in these cases does it appear that the Courts relied on the type of steps, thoughts or discussions relied upon by Snyder which may have preceded the creation of the work.

The end product is of major importance in resolving the issue of copyright validity. In this connection, it is pointed out that even copying entails a minimum of effort. Thus, to make a copy necessarily requires taking many of the very steps

taken by Snyder. To make a copy of another's work still requires having discussions with manufacturers, making decisions on materials to be used, making sketches or drawings, and so on. Thus, even if such minute details were to be shown, it is not seen how these are germane on the issue of copying, not copying or copyright invalidity.

If Snyder had independently created the "Uncle Sam" bank or departed sufficiently from the public domain bank, he would be entitled to a copyright even though the bank also had a functional or utilitarian aspect. However, Snyder has copied both the functional as well as the decorative features. Insofar as any trivial differences which may exist between the original antique and Snyder's plastic version these were dictated in the copying process by utilitarian, mechanical or economic factors and, therefore, should not be accorded any weight whatsoever since they did not result out of "authorship" in the copyright sense.

VI.

SNYDER'S COPYRIGHT SHOULD ADDITIONALLY
BE DECLARED INVALID BECAUSE THE COPYRIGHT
NOTICE ON ITS PUBLISHED COPIES WAS
INSUFFICIENT

Publication of a work without sufficient copyright notice
invalidates the copyright. See generally Nimmer on Copyright,
Sections 81, 82. At page 30, Nimmer states:

"In this primary arena of copyright, failure
to comply with the requisite formalities will often
result in discharging the work into the public
domain. Thus the failure to affix a copyright
notice in proper form and in the proper place
on published copies of the work may prove fatal
either to a claim of copyright or to its
maintenance."

The Copyright Office itself warns potential applicants
in its Circular No. 3 as follows:

"NOTE: Once a work has been published without the
required copyright notice, copyright protection
is lost permanently and cannot be regained. Adding
the correct notice later will not restore protection
nor permit the Copyright Office to register a
claim." (Emphasis by Copyright Office)

Snyder has published his "Uncle Sam Banks" with the
following notice:

"© Copyright J.S.N.Y."

The cartons in which Snyder's banks are sold bear the following
notice:

"© Copyright J.S.N.Y. 1975"

Amicus respectfully submits that these forms of copyright
notice are insufficient and publication of Snyder's banks with

these notices divested all copyrights, to the extent that they may ever have existed, into the public domain. Section 19 of the Copyright Act, in its pertinent parts, reads as follows:

"§19. NOTICE; FORM.--The notice of copyright required by section 10 of this title shall consist either of the word 'Copyright', the abbreviation 'Copr.', or the symbol ©, accompanied by the name of the copyright proprietor, and if the work be a printed literary, musical, or dramatic work, the notice shall include also the year in which the copyright was secured by publication.

In the case, however, of copies of works specified in subsections (f) to (k), inclusive, of section 5 of this title, the notice may consist of the letter C enclosed within a circle, thus ©, accompanied by the initials, monogram, mark, or symbol of the copyright proprietor: Provided, that on some accessible portion of such copies or of the margin, back, permanent base, or pedestal, or of the substance on which such copies shall be mounted, his name shall appear." (Emphasis added)

The basic form of notice contemplated by the first sentence of §19 requires the "name of the copyright proprietor". The second sentence of §19 permits the use of the initials, for example, of the copyright proprietor with respect to works specified in §5(f) through (k), provided that the name of the proprietor appears elsewhere on the work.

Since Snyder only used the initials on his "Uncle Sam" Banks, this notice does not appear to satisfy the first sentence of §19. The second sentence of §19 is similarly not complied with since the name of the proprietor does not appear elsewhere on the work to supplement the use of the initials in the notice. Snyder

only used the proprietor's initials with respect to both the banks and the packaging therefor and since the full name of the proprietor does not appear anywhere in connection with the product, the notice is insufficient and the copyright is invalid. Puddu v. Buonamici Statuary, Inc., 450 F.2d 401 (2d Cir. 1971).

While some have argued that the use of a well-advertised or widely known trademark or tradename on the copyrighted article will serve as the "proprietor's name" under the first sentence of §19, and therefore obviate the need to comply with the proviso of the second sentence of §19, it is respectfully submitted that the initials "J.S.N.Y." are not advertised or widely known to the public as a trademark or tradename and do not therefore come within this court-made exception to the general rule mandated by §19.

Puddu v. Buonamici Statuary, Inc., supra.

Herbert Rosenthal Jewelry v. Grossbardt, 436 F.2d 315 (2d Cir. 1970), and L. & L. White Metal Cast Corp. v. Cornell Metal Spec. Corp., 353 F.Supp. 1170 (E.D. N.Y. 1972) are generally in accord with the Puddu case. However, in each of these two cases, the initials used in the copyright notices were found to constitute the proprietor's names. In each case, the initials had become widely known over long periods of time. Additionally, in each case the initials constituted trademarks under which the goods were sold. In the Herbert Rosenthal case, the plaintiff had used the initials "HR" as a trade name or mark since 1945, and received a trademark registration just three months after the bee was first

sold with the initials "HR" in the copyright notice. In the L. & L. White case, the initials L&LWMC was a registered trademark before and after the use of the initials in the copyright notice and the initials were shown to be widely advertised on "all of its advertising brochures".

Based on the cases decided in this Circuit, it appears that for the initials of a copyright proprietor to be suitable for use in a copyright notice under the first sentence of §19 (not requiring compliance with the proviso of the second sentence), the initials must have acquired a secondary meaning in the trademark sense and have become equivalent to the proprietor's name in the eyes and minds of the public. Mere use of initials in copyright notices does not establish the initials as an equivalent to the name itself and therefore can only be used in a sufficient copyright notice under the second sentence of §19 when the proviso is complied with. This is not the instance in this case and, accordingly, Snyder's copyright notice on its "Uncle Sam" Banks is insufficient as not complying with the mandate of §19 nor as falling within the court-made exception discussed above.

Based on the defendants-appellants' position in the lower court in the related case of Etna Products Co., Inc. et al v. E. Mishan & Sons, 75 Civ. 428, it appears that defendants-appellants rely on the first sentence of Section 19 of the Copyright Act, as

they must since they have not complied with the proviso of the second sentence.

Accordingly, defendants-appellants suggested that the initials "J.S.N.Y." are a trademark. Although the initials have never before been characterized as such, defendants-appeallants have curiously started in the lower court proceedings to precede the initials "J.S.N.Y." by the word "trademark". However, characterizing the initials as a trademark at this time does not make the initials a trademark.

As is well established, the elements of a trademark include:

"(1) the tangible symbol: a word, name, symbol or device or any combination of these; (2) type of use: actual adoption and use of the symbol as a mark by a manufacturer or seller of goods or service (3) the function: to identify and distinguish the seller's goods made or sold by others."

Trademarks and Unfair Competition, McCarthy, Section 3.1; see Trademark Law and Procedure, Vandenburg, Second Edition, Section 1.20. It is axiomatic that for a mark to be a trademark it must be used as a trademark in conjunction with goods and it must be intended to identify the source thereof to the public. As such, trademarks serve as instruments in advertising and selling the goods to the public. Trademark and Unfair Competition, supra, Section 3.5.

In the Mishan case, Jeffrey Snyder, in an affidavit, made it very clear that the initials are not and were never intended to serve as a trademark. In fact, Snyder in that affidavit swore that

the initials were used to prevent the public from knowing the source of the goods. Snyder indicated in the affidavit that he used his initials because customers at wholesale do not want the name of the manufacturer or importer on the product. Presumably, the wholesalers who sell at retail place their own trademark on the goods. For this reason, importers who sell to jobbers adopt some minor symbols or codes which, while not objectionable to the jobbers and do not interfere with the jobbers' trademarks, identify the goods to the importers themselves. This is primarily for the purpose of identifying returned goods and is a common practice used by importers.

Based on the above, it can hardly be said that the use of Snyder's initials as above described constitutes a trademark use. In fact, the initials served not so much as an identification of source for the benefit of the consuming public as for the benefit of the defendants-appellants themselves.

Nowhere do the defendants-appellants state that the initials were used in a trademark sense, that the initials were advertised as a trademark or that steps have been taken to perfect trademark rights by application for State or Federal trademark registration. In view of Snyder's characterization of the initials and their intended use, Snyder cannot now take the inconsistent position that the initials are a true trademark.

On what basis, then, do defendants - appellants base their allegations that "J.S.N.Y." is a trademark? In the Snyder Affidavit referred to above, it is stated that the initials "J.S.N.Y." have been applied to those products designed by Snyder, or commissioned by him, which he contemplated copyrighting. In effect, defendants-appellants are stating that the mere use of the initials in a copyright notice constitutes a trademark use. This is clearly not so. Insofar as the public is concerned, the name in an alleged copyright notice does not serve as a designation of source of origin, which is what a trademark is supposed to do. At best, it may indicate that some entity (J.S.N.Y.) is claiming some aspect of copyright protection in the item. To demonstrate the fallacy of the defendants-appellants' reasoning, Amicus suggests the following analogy. Frequently T-shirts, school supplies, etc. are imprinted with reproductions of copyrighted characters, such as cartoon characters. The use of the reproductions is typically under license of the copyright owner and the copyright notice appears next to the characters. Does the name of the copyright owner in the notice become a trademark? Does the copyright owner's name designate the origin of the T-shirts, school supplies, and the like? Does his name become a trademark designating the source of the goods? The answer is clearly no to each question. The ownership of a copyright on a particular aspect of a product and the ownership of a trademark which designates the source of the product are entirely distinct. There

is no basis whatsoever to confuse the two and claim, as defendants-appellants are now attempting, that the proprietor in a copyright notice automatically, in and of itself, also becomes either a trademark or tradename.

In the Snyder Affidavit referred to, it is stated that the initials "J.S.N.Y." have been used to identify works originating with Snyder and have been used as a trademark. Such use has allegedly existed for two years. However, this has not been a use for even one day in a trademark sense. In effect, defendants-appellants are trying to pull themselves up by their own bootstraps. First, they claim that the initials "J.S.N.Y." have been used for two years in copyright notices on items originating with Snyder. Second, they claim that such use of the initials in the copyright notices have constituted a trademark use and that, therefore, the notices are valid since the proprietor's name "J.S.N.Y." is a trademark. Amicus submits that such reasoning is circular, in that the use of the initials "J.S.N.Y." in and of itself in copyright notices makes all these notices insufficient and invalid. Surely, the defendants-appellants cannot contend that the mere repeated use of the same invalid copyright notice on different products cures the basic defect on any one such notice. Since "J.S.N.Y." did not constitute a trademark on any one of Snyder's items, these initials did not acquire that status by mere repetition on a plurality of items.

Defendants-appellants next alleged in the Mishan case that the Copyright Office was informed of the use of the initials. In this connection, reference is made to the Compendium of Copyright Office Practices (1973), Section 4.2.3.II.d.2.b and Section 4.2.3.II.d.5. The Copyright Office requires that the claimant's name (e.g. initials) be known to the "public generally as distinguished from the trade itself or from the specialized public in the trade." However, ordinarily the Copyright Office "will not question an applicant's assertion to this effect and will not require him to submit proof of his statement." The Copyright Office is not in a position to determine if an applicant's initials are in fact his true name to the general public and, therefore, rely on applicant's assertion to this effect. For this reason, there is no merit whatsoever to give weight, as defendants-appellants suggest, to the fact that the Copyright Office registered Snyder's copyright. While the Copyright Office personnel may be well versed in correct copyright proprietor identification, the Compendium of Copyright Office Practices, a manual for the Copyright Office Personnel, instructs this personnel to accept the claimant's assertion of public knowledge of its initials. Clearly, this may result in copyright registrations being issued on the basis of invalid or insufficient copyright notices, and Amicus submits that this is precisely what has happened here in connection with Snyder's copyright registration.

The facts here are most similar to those in the Puddu v. Buonamici Statuary, Inc., supra, where the notice was held insufficient.

For reasons stated above, use of the initials "J.S.N.Y." in the copyright notices has not and can never constitute a trademark use. This in and of itself distinguishes this case from the facts in Herbert Rosenthal Jewelry Corp. v. Grossbardt, supra, Tennessee Fabr. Co. v. Moultrie Mfg. Co., 421 F.2d 279 (5 Cir. 1970), and L. & L. White Metal Cast Corp. v. Cornell Metal Spec. Corp., supra. In each case, the initials constituted a true trademark use and a trademark registration was issued therefor. Also, in each of these cases, the initials served as a trademark well known to the general public as such for long periods of time. Thus, in the Herbert Rosenthal case, supra, the use of the trademark "HR" was for 25 years. In the L. & L. White case the copyright owner used the trademark "L & L WMC" for 35 years. Here Snyder admits that he has used the initials or code "J.S.N.Y." for only two years and that the use of the initials during that period was not a use in the trademark sense to identify the source of the goods to the public. Finally, in the above-cited cases, the initials were shown to have appeared on all advertising to inform the public that the initials were indicia of the sources of supply. Here, on the other hand, Snyder has sworn in an affidavit that the initials were intended to hide or conceal the true source of the goods from the ultimate public -- the antithesis of a true trademark use.

The Puddu case, supra, presents the facts most similar to the instant case. Finding the initials "ARP" in the copyright notice insufficient, the Second Circuit Court found the above requirements missing, namely, a well known and advertised trademark used for a long period of time. These requirements, Amicus submits, are equally missing in this case. In Puddu, as in this case, the initials were primarily used in the copyright notices. This, the Court held on page 404, was insufficient advertising to make the mark well known.

In the Puddu case, as here, the copyright claimant had filed a certificate of doing business under the initials "ARP". In this connection, the Puddu Court stated at page 404:

"The filing of a certificate permitting Puddu to do business under the assumed name of 'ARP' is a long way from the proof held sufficient in these prior cases. We thus cannot say that...the appellant has complied, in 'substance' with the requirements of Section 19." (Emphasis added).

VII.

CONCLUSIONS

This Court must reverse its decision of October 24, 1975 in this case to be consistent with the long line of cases in this Circuit which have carried out the constitutional mandate to award monopolies only to "authors". This Court has consistently refused to go beyond and sustain unlawful monopolies to those who have not "promoted the progress of science and useful arts". This Court must protect the public and commerce from those that would seek and obtain such unlawful monopolies.

At best, the alleged author in this case, Snyder, produced a "bad copy". He failed to reproduce the public domain "Uncle Sam" bank with the precision and exactitude that would entitle him to claim shelter under the "Hand of God" fact pattern. What differences did result are below the minimum level required by the courts to support a valid United States copyright.

There is nothing in this case that calls for or warrants a departure of this Court from its time tested and constitutionally sound position. In addition to not being an author, Snyder used an insufficient notice and it is beyond question that this divested Snyder of any copyrights which he may otherwise have had.

Respectfully submitted,

E. MISHAN & SONS, INC.

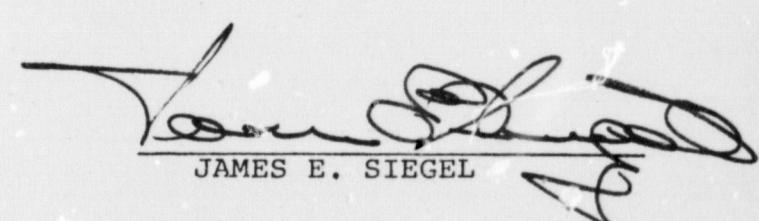
By: 

JAMES E. SIEGEL, ESQ.
MYRON GREENSPAN, ESQ.
Lackenbach, Lilling & Siegel
41 East 42nd Street
New York, New York 10017
(212) 986-7630

Dated: New York, New York
January 12, 1976

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing Brief of E. Mishan & Sons, Inc. as Amicus Curiae was duly served upon Robert C. Faber, Esq. and Messrs. Ostrolenk, Faber, Gerb & Soffen, attorneys for Defendants-Appellants, and Mark H. Sparrow, Esq. and Messrs. Jacobs & Jacobs, P.S., attorneys for Plaintiff-Appellee, by hand-delivering same to their offices at 260 Madison Avenue, New York, New York, and 521 Fifth Avenue, New York, New York, respectively, this 12th day of January, 1976.


JAMES E. SIEGEL